

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE W. BURGER

Appeal No. 2004-1228
Application No. 09/813,088

ON BRIEF

Before GARRIS, WALTZ, and DELMENDO, Administrative Patent Judges.
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's final rejection of claims 1 through 7, 18 through 32, and 40 through 46 (final Office action mailed Aug. 9, 2002, paper 13) in the above-identified application. Claims 10 through 17 and 33 through 39, the only other pending claims, stand withdrawn from further consideration pursuant to 37 CFR § 1.142(b)(2003)(effective Dec. 22, 1959).

The subject matter on appeal relates to a shaft for a hockey stick (claims 23 through 32) and to a hockey stick (claims 1 through 7, 18 through 22, and 40 through 46). Further details of this appealed subject matter are recited in representative claims

1, 2 through 6, 18, 23, and 40 reproduced below:

1. A hockey stick, comprising, in combination:
a shaft;
said shaft formed from a composite layup including
a hollow core;
a blade having a hosel portion attached into said
hollow core of said shaft;
a sheath formed from resilient material ensconcing
said shaft and terminating adjacent said hosel.

2. The hockey stick of claim 1 wherein said
composite layup is comprised of a plurality of graphite
sheets.

3. The hockey stick of claim 2 wherein said
graphite sheets are impregnated with resin, and affixed
to each other by said resin.

4. The hockey stick of claim 3 wherein said
resilient material runs the length of said shaft.

5. The hockey stick of claim 4 wherein said
resilient material is rubber.

6. The hockey stick of claim 5 wherein said layup
further comprises a urethane sheet.

18. A hockey stick, comprising, in combination:
a shaft; and
a blade removeably [sic] attached to said shaft;
said shaft formed by laying up a plurality of
uncured resin-impregnated sheets of composite material,
forming said plurality of sheets about a mandril,
defining a layup wrapped mandril, ensconcing a
resilient sheath over said layup wrapped mandril,
vulcanizing said sheath and layup wrapped mandril
combination, and removing the mandril.

23. A shaft for a hockey stick, comprising, in
combination:
a composite layup including a hollow core having
an end to allow placement of a blade hosel portion
therein; and
a sheath formed from resilient material ensconcing
said layup.

40. The hockey stick of claim 1 including a cuff located on an interior of said hollow core of said shaft, adjacent said hosel portion, and overlying said hosel portion.

The examiner relies on the following references as evidence of unpatentability:

Cecka et al. (Cecka)	4,212,461	Jul. 15, 1980
Rodgors	5,419,553	May 30, 1995
Burger	6,206,793 B1 (filed Dec. 23, 1997)	Mar. 27, 2001
Kline (Canadian patent document)	557,838	May 27, 1958

The appealed claims stand rejected as follows:

- I. claims 18 through 22 under the first paragraph of 35 U.S.C. § 112 "as containing new matter" (examiner's answer mailed Oct. 21, 2003, paper 19, page 3; Office action mailed Nov. 6, 2001, paper 7, page 2);
- II. claims 1, 18 through 25, 30, 31, 40, 41, 43, and 44 under 35 U.S.C. § 103(a) as unpatentable over Rodgors in view of Kline (answer, page 3; Nov. 6, 2001 Office action, page 3);
- III. claims 2 through 6 and 26 through 28 under 35 U.S.C. § 103(a) as unpatentable over Rodgors in view of Kline and Cecka (answer, page 3; Nov. 6, 2001 Office action,

page 3)); and

IV. claims 1 through 7, 18 through 32, and 40 through 46 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1 through 8 of Burger (answer, page 3; Nov. 6, 2001 Office action, page 4).

We reverse rejection I but affirm rejections II through IV for essentially those reasons set forth by the examiner.¹

I. 35 U.S.C. § 112, ¶1, Written Description:
Claims 18-22

As an initial matter, it is important to emphasize that the examiner bears the initial burden of presenting a prima facie case of unpatentability, whether it be based on prior art or on any other ground. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "Insofar as the written description requirement is concerned, that burden is discharged by

¹ Regarding rejection IV, the appellant submits that all claims stand or fall together.' (Substitute appeal brief filed Jul. 31, 2003, paper 18, p. 9.) As to rejections II and III, the appellant urges that the claims are separately patentable. (Id.) We point out, however, that merely pointing out differences in what the claims cover is not an argument for separate patentability within the meaning of 37 CFR § 1.192(c)(7)(2003)(effective Apr. 21, 1995). Nevertheless, we will consider the claims separately to the extent that the appellant argues them separately within the meaning of the regulation.

'presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.'" In re Alton, 76 F.3d 1168, 1175-76, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996)(citing In re Wertheim, 541 F.2d 257, 263-64, 191 USPQ 90, 97 (CCPA 1976)).

To satisfy the written description requirement of 35 U.S.C. § 112, first paragraph, the disclosure of the application as originally filed must reasonably convey to those skilled in the relevant art that the applicant, as of the filing date of the original application, had possession of the claimed invention. Alton, 76 F.3d at 1172, 37 USPQ2d at 1581; In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The applicant, however, does not have to describe exactly the subject matter claimed. Union Oil Co. of Cal. v. Atlantic Richfield Co., 208 F.3d 989, 997, 54 USPQ2d 1227, 1232, 1233 (Fed. Cir. 2000).

In the present case, the examiner contends that the specification does not adequately describe any "provision for a removably attached blade." (Nov. 6, 2001 Office action, page 2.) Specifically, the examiner takes the position that while "one skilled in the [relevant] art might realize from the reading the specification that [the] applicant's proposed interpretation may be one possibility among others," this is insufficient for purposes of satisfying the written description requirement.

(Answer, page 4.) According to the examiner, "one may just as easily read the appellant's disclosure as providing a permanently joined blade." (Id.)

We cannot agree with the examiner on this issue. The present specification describes (page 13, lines 21-23): "[O]ne has a grip ensconced shaft as depicted in figure 7 which may be mated, preferably with blade B, by inserting blade B's hosel portion 13 into receptacle or cuff 14 to form a hockey stick 10." While the specification does not expressly state that the blade, once inserted into the shaft, is removable, there is also no indication that the blade is permanently attached to the hockey shaft. Because the blade must be either permanently or removably attached (e.g., Rodgors) to the shaft, it is our judgment that the specification as originally filed would have reasonably conveyed to one skilled in the relevant art that the appellant, as of the filing date, had possession of the invention recited in the appealed claims.

The examiner's reliance on In re Barker, 559 F.2d 588, 593, 194 USPQ 470, 474 (CCPA 1977) is misplaced. In Barker, the court held that a claim specifying a step of selecting a backboard having a length equal to the width of at least six shingles violated the written description requirement because the specification and drawings disclosed only "backing boards of four

and eight foot lengths having a repetitive series of eight or sixteen shingles thereon." Unlike the situation in Barker, the present specification describes a hockey stick in which the blade must be attached to the shaft in one of only two possible ways - i.e., either removably or permanently.

For these reasons, we cannot affirm the examiner's rejection on this ground.

II. 35 U.S.C. § 103(a): Claims 1, 18-25, 30, 31, 40, 41, 43, & 44 over Rodgors & Kline

We agree with the examiner's reasoning (answer, pages 5-6; Nov. 6, 2001 Office action, page 3) that the prior art teachings would have led one of ordinary skill in the art to combine Rodgors and Kline. Rodgors describes a hockey stick shaft in the form of an elongated tubular member formed as a plurality of discrete layers of bondable material (i.e., a composite layup), such as layers made of unidirectional carbon fiber rovings.² (Column 2, lines 18-22; column 3, line 36 to column 4, line 62; Examples 1 and 2; Tables 1-3.)

Kline teaches a protective coating 17 (e.g., "smooth hard

² The disclosure in Rodgors of multiple layers of carbon fibers would have at least suggested a plurality of sheets made from graphite fibers as recited in appealed claim 2, which is discussed in rejection III. See Hawley's Condensed Chemical Dictionary 212, 551 (Van Nostrand Reinhold 13th ed. 1997), copy attached.

rubber") along the entire central shaft portion 12 to "provide[] a hockey stick that is both sturdy, weather-proof, and easy to handle." (Column 1, line 47 to column 2, line 18.) As pointed out by the examiner (answer, page 5), Kline teaches that the protective coating may be applied to shafts of the type described in Rodgors. (Column 1, lines 42-46.)

Hence we share the examiner's view that one of ordinary skill in the art would have found it prima facie obvious to modify the shaft described in Rodgors to include Kline's elastomeric coating on its outer surface in order to obtain all of the advantages described in Kline, thus arriving at a hockey shaft encompassed by appealed claim 23. The hypothetical person having ordinary skill in the art would have carried out this modification of Rodgors with a reasonable expectation of success.

Moreover, Rodgors further teaches that the shaft may be provided with a thin outside surfacing veil made of a thermoplastic (i.e., resilient) polyester. (Column 4, lines 63-67.) From this teaching, we determine that Rodgors describes each and every limitation recited in appealed claim 23. Although the examiner's rejection of appealed claim 23 has been made under 35 U.S.C. § 103(a), a prior art disclosure that anticipates under 35 U.S.C. § 102 also renders the claim obvious, for anticipation is the epitome of obviousness. In re Baxter Travenol

Laboratories, 952 F.2d 388, 391, 21 USPQ2d 1281, 1284-85 (Fed. Cir. 1991); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re May, 574 F.2d 1082, 1089, 197 USPQ 601, 607 (CCPA 1978).

The appellant argues that "Rodgors discloses a carbon and glass fiber hockey stick shaft which, by its construction, is 'relatively indestructible'" and that "[t]he addition of the sheath of the present invention to Rodgors' stick shaft would therefore be superfluous..." (Substitute appeal brief, pages 12-13; 37 CFR § 1.132 (2003)(effective Nov. 29, 2000) declaration of Tom Omuhundro.) We note, however, that Rodgors describes each and every limitation of appealed claim 23. Furthermore, Kline provides a reason to apply a coating on the shaft of Rodgors for the purpose of improving sturdiness, weather-resistance, and ease of handling. It does not matter that Rodgors teaches a shaft that is "relatively indestructible," because one of ordinary skill in the art would have been led to apply Kline's coating for all of the disclosed advantages including, but not limited to, a further improvement in sturdiness.

The appellant urges that while Rodgors discloses a replaceable handle portion, "[t]he instant invention is a one-piece shaft with means for binding the sheath to it and for attaching a blade." (Substitute appeal brief, page 13; 37 CFR §

1.132 declaration of Tom Omuhundro.) This position is without any merit. Nothing in the actual language of appealed claim 23 precludes a replaceable handle portion as shown in Rodgors. Also, "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.[] Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The appellant alleges that Rodgors's thermoplastic coating "precludes further coating of the stick with the sheath of the present invention." (Substitute appeal brief, page 13; 37 CFR § 1.132 declaration of Tom Omuhundro.) We do not subscribe to this argument because the appellant and Mr. Omuhundro fail to identify the factual basis for this conclusory statement. On this point, it is well settled that mere lawyer's arguments and conclusory statements, which are unsupported by factual evidence, are entitled to little probative value. In re Geisler, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); In re Lindner, 457 F.2d 506, 508-09, 173 USPQ 356, 358 (CCPA 1972).

Regarding appealed claims 18 through 22, we agree with the

examiner's determination (answer, page 6) that the claim limitations are product-by-process limitations that have not been shown to distinguish over the prior art. When a product recited in a product-by-process claim reasonably appears to be the same as or obvious from a product of the prior art, the burden is on the applicant to show that the prior art product is in fact different from the claimed product, even though the products may be made by different processes. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

With respect to appealed claim 40, the appellant contends that Rodgors does not disclose a "cuff" as recited in the claim. (Substitute appeal brief, page 15.) We agree with the examiner's determination (answer, pages 6-7) that the appellant's contention regarding a cuff is also without merit. It is well settled that, in proceedings before the United States Patent and Trademark Office (PTO), claims in an application are to be given their broadest reasonable interpretation, taking into account the written description found in the specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow."); In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir.

1984)("The PTO broadly interprets claims during examination of a patent application since the applicant may 'amend his claim to obtain protection commensurate with his actual contribution to the art.'")(quoting In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)).

Contrary to the appellant's belief, the present specification contains no special definition for the term "cuff." It is appropriate, therefore, to give the term its ordinary meaning as would be understood by one skilled in the relevant art. Webster's Third New International Dictionary 551, copy attached, defines the term "cuff" as "the part of a glove covering the wrist and sometimes the forearm" and "something resembling or likened to a cuff for the wrist (as the ferrule on a tool handle)." Thus, the examiner's interpretation (answer, pages 6-7) of the term "cuff" to encompass Rodgors's sleeve portion of the hockey shaft overlying the reduced neck portion of the blade 24 is reasonable.

Accordingly, we uphold the examiner's rejection on this ground.

III. 35 U.S.C. § 103(a): Claims 2-6 & 26-28
over Rodgors, Kline, & Cecka

Appealed claim 2 recites that the "composite layup is comprised of a plurality of graphite sheets." Again, we agree

with the examiner's analysis (answer, page 7) as to this claim. Moreover, as we discussed above, the disclosure in Rodgors of multiple layers of carbon fibers would have disclosed or suggested to one of ordinary skill in the art a plurality of sheets made from graphite fibers as recited in appealed claim 2. See Hawley's Condensed Chemical Dictionary 212, 551 (Van Nostrand Reinhold 13th ed. 1997).

As to appealed claim 6, the appellant does not provide any argument on why the examiner's reasoning (answer, page 8; Nov. 6, 2001 Office action, page 3) is in error. Accordingly, no basis for reversal exists.

The 37 CFR § 1.132 declaration of Mr. Mark Messier, a professional hockey player, is unpersuasive. While Mr. Messier states that the present invention reduces broken sticks by approximately 20%, the factual basis for this conclusion is nowhere discussed. For example, Mr. Messier fails to mention the nature and extent of the comparison between the claimed invention and the control hockey stick. That is, Mr. Messier does not state whether the control stick is of the type described in the closest prior art, which is Rodgors who teaches a stick satisfying all of the limitations recited in appealed claim 23. Nor does Mr. Messier address the specifics of the comparative study, e.g., the duration of the comparative study and the

particulars of the data that might support his conclusion.

Accordingly, we uphold the examiner's rejection on this ground.

IV. Double Patenting: Claims 1-7, 18-32, & 40-46

The judicially-created doctrine of obviousness-type double patenting prohibits a party from obtaining an extension of the right to exclude granted through claims in a later patent that are not patentably distinct from claims in a commonly-owned earlier patent. Ely Lilly & Co. v. Barr Laboratories, Inc., 251 F.3d 955, 967, 58 USPQ2d 1869, 1877-78 (Fed. Cir. 2001)(citing In re Longi, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985)). According to our reviewing court, "a double patenting rejection of the obviousness type rejection is 'analogous to a [failure to meet] the nonobviousness requirement of 35 U.S.C. § 103,' except that the patent document underlying the double patenting rejection is not considered prior art." In re Longi, 759 F.2d at 892 n.4, 225 USPQ at 648 n.4.

Instead of filing a terminal disclaimer or arguing the merits of the examiner's rejection to overcome the rejection, the appellant urges (substitute appeal brief, page 20):

Undersigned observes that had the Examiner given patentable weight to the claim limitations of the instant application while those claims were in the parent case, applicant would not have been faced with

the economic decision of having to pursue the patents to issue piecemeal. It is believed that in light of the delay in allowing these claims, extension of the patent term would be appropriate. The extension of term should be the delay attributable to the patent office.

The appellant's position is utterly without merit and quite untenable. It was the appellant who made a strategic decision not to pursue the appealed claims in the parent application. Under these circumstances, there is no justification for allowing an extension of the patent term.

Summary

For these reasons and those set forth in the answer, we reverse the rejection under 35 U.S.C. § 112, first paragraph, of appealed claims 18 through 22 as violating the written description requirement. We affirm, however, the rejections under: 35 U.S.C. § 103(a) of appealed claims 1, 18 through 25, 30, 31, 40, 41, 43, and 44 as unpatentable over Rodgors in view of Kline; 35 U.S.C. § 103(a) of appealed claims 2 through 6 and 26 through 28 as unpatentable over Rodgors in view of Kline and Cecka; and the judicially created doctrine of obviousness-type double patenting of appealed claims 1 through 7, 18 through 32, and 40 through 46 as unpatentable over patented claims 1 through 8 of Burger.

The decision of the examiner to reject all of the appealed

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claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Bradley R. Garris)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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Administrative Patent Judge)	APPEALS AND
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Appeal No. 2004-1228
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